

Application No. 09/869,282
Amendment dated June 3, 2011
Reply to Office Action of January 5, 2011

REMARKS

**Reconsideration And Allowance
Are Respectfully Requested.**

Claims 237-260 are currently pending. Claims 237, 238, 244, 250 and 257-260 have been amended. New claims 261-264 have been added. Claims 1-236 were previously canceled. No new matter has been added. Support for the new claims and amendments to the independent claims can be found at Page 20, lines 28-30 of the original specification. Reconsideration is respectfully requested.

Claims 237-260 have been rejected multiple times under obviousness-type double patenting in view of eight different pending applications. At this time the claims of all of these applications are subject to change. As such, until allowable subject matter is indicated in any of these applications a proper determination of obvious type double patenting cannot be made. Therefore, it is requested that these rejections be held in abeyance until allowable subject matter is indicated.

Claims 237-260 have also been rejected under obviousness-type double patenting in view of 3 issued patents all having common ownership with the present application. These rejections are deemed to be improper. This application and the three patents are directed to markers or methods of inserting markers, but each is directed to different and distinct features of the markers or methods. In fact, the claims as currently amended are not similar in scope

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to any of the claims in the issued patents cited in the outstanding Office Action. Just because all of the cited patents and the current application include claims that relate to a detectable marker does not in and of itself render them obvious in view of each other.

With regard to the 35 U.S.C. § 103 rejection of claims 237-240, 241-258 and 260 based upon U.S. Patent Application Publication No. 2002/0058883 to Fulton (Fulton) in view U.S. Patent No. 5,320,100 to Herweck et al. (Herweck), this rejection is traversed for the following reason.

All of the independent claims, in particular claims 237, 244, 250 and 257, as now amended recite the marking device comprises a first component and a second component. They further all recite, in one form of language or another, that the first component is a wound arrangement of bioabsorbable suture material and the second component is a unitary piece of metal forming a marker, wherein the second component is carried and supported by the wound arrangement of the first component.

This claim structure is not shown, disclosed or rendered obvious by Fulton or Herweck alone or in combination.

Obviousness under 35 U.S.C. § 103 involves underlying factual considerations regarding (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed invention, (3) the level of ordinary skill in the art, and (4) the relevant secondary considerations. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1996). A claimed

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invention is invalid as being obvious "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains". 35 U.S.C. § 103.

A *prima facie* rejection based upon obviousness requires that the prior art reference (or references when combined) teach or suggest all of the claim limitations. In order to do this requires that the claims be construed in light of the specification as one of ordinary skill in the art would understand the terms used therein. Phillips v. AWH Corp., 415 F.3d 1303, 1312-13 (Fed. Cir. 2005) (en banc).

The rejected claims recite a suture material in a wound arrangement carrying and supporting a unitary metal piece. The claimed structure is not disclosed by either Fulton or Herweck. Thus, regardless of how the teachings of Fulton and Herweck are combined they fail to teach the claimed invention. As such, each and every feature of the claimed invention is not disclosed as required by Phillips.

With regard to various dependent claims, the Office Action fails to properly address the recited limitations. In claims 239 and 246, the first component has been claimed to be flexible and the Office Action fails to address this limitation. In claims 241 and 248, the second component has been claimed to be formed in a shape other than a sphere and the Office Action fails to address this limitation. In claims 242 and 249, the suture material of the

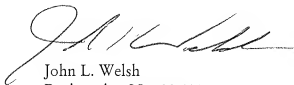
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first component is claimed to be bent and the Office Action fails to address this limitation. Lastly, claim 243 recites that the lumen of the elongated member includes internal walls and the first component is resilient and in contact with the internal walls when preloaded within the elongate member, and the Office Action fails to address this limitation.

As such, the dependent claims are deemed to be allowable for at least the reasons set forth with regard to independent claims 237, 244, 250 and 257 above.

It is believed that this case is in condition for allowance and reconsideration thereof and early issuance is respectfully requested. If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact Applicants' representative at the below number.

Respectfully submitted,



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